

Appn. No.: 10/643,881  
Amendment Dated July 17, 2006  
Reply to Office Action of April 25, 2006

**Remarks:**

With this amendment, claims 39 and 65 are amended to recite that nylon 66 is present in an amount of at least 90% by weight. Support for these amendments can be found in the application as filed; therefore, no new matter has been added. In addition, this feature was recited in now cancelled claims 42, 43, and 66. Accordingly, no new issue for further search and/or consideration is presented.

Claims 12-15, 18-28, and 32-38, 40, 41, 44-65, and 67 are pending.

The Applicants appreciate the time Examiners Pearse and Cano took during the telephone interview of 19 June 2006. During that interview, the Applicants' representatives discussed the lack of specificity in the teachings of Berrier et al., the claimed 90% by weight feature, the Reynolds® Oven Bag described by Berrier et al., and a proposed technical declaration (submitted herewith) comparing a bag made from a film of the present invention with a Reynolds® Oven Bag.

**I. The Office Action**

**A. 35 U.S.C. § 112 Rejection**

Claims 41-45 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite because the phrase "wherein the single layer" does not appear to have proper antecedent basis. The Applicants submit that with the amendments to claim 39, i.e., the bag being a single layer, the indefiniteness rejection has been overcome.

**B. 35 U.S.C. § 102(e) Rejection**

The Office Action rejects claims 13-19, 21-28, 32, 33, 35, 36, 39-45, 47-63, and 65-67 under 35 U.S.C. § 102(e) as anticipated by Berrier et al. (U.S. Application Publication No. 2004/0121054).

**C. 35 U.S.C. § 103(a) Rejection**

The Office Action rejects claims 34, 37-59, 62, and 63 under 35 U.S.C. § 103(a) as obvious over Berrier et al. in view of Barr et al. (U.S. Patent No. 6,422,454) and Hoffman (U.S. Patent No. 3,454,211). Berrier et al. is acknowledged as failing to teach a gap forming between the product and the bag, and that the

product and bag are disposed in an outer container. The Office Action concludes that because the film of the bags in Berrier et al. and as claimed are similar, it would have been expected that the bag of Berrier et al. would form the claimed gap. Barr et al. is cited as teaching that it is well-known to package individually-sized food products in other containers. The motivation supplied to combine the teachings of Barr et al. with Berrier et al. is that incorporating an outer container to hold the meat product of Berrier et al. would improve the ease of preparation for the consumer.

The Office Action rejects claim 64 under 35 U.S.C. § 103(a) as obvious over Berrier et al. in view of Hoffman. Berrier et al. is acknowledged as failing to teach a gap forming between the product and the bag, and that the bag has chamfered edges at one end. The Office Action concludes that because the film of the bags in Berrier et al. and as claimed are similar, it would have been expected that the bag of Berrier et al. would form the claimed gap. Hoffman is cited as disclosing a bag with chamfered edges. The motivation supplied to modify the bag of Berrier et al. in view of the chamfered-edge bag in Hoffman is because it is simply a matter of design choice to chamfer the bag edges and the chamfered edges would keep products away from the bag corners, which would be similar to the function of keeping the meat product intact.

The Office Action rejects claims 64-67 under 35 U.S.C. § 103(a) as obvious over Berrier et al. in view of Barr et al. Berrier et al. is acknowledged as failing to teach a gap forming between the product and the bag, and that the product and bag are disposed in an outer container. The Office Action concludes that because the film of the bags in Berrier et al. and as claimed are similar, it would have been expected that the bag of Berrier et al. would form the claimed gap. Barr et al. is cited as teaching that it is well-known to package individually-sized food products in other containers. The motivation supplied to combine the teachings of Barr et al. with Berrier et al. is that incorporating an outer container to hold the meat product of Berrier et al. would improve the ease of preparation for the consumer.

**D. The Examiner's Response to Applicants' Arguments**

The Office Action cited to *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628 (Fed. Cir. 1987) as standing for the proposition that a claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently, in a

single prior art reference. The Office Action cited to *Brown v. 3M*, 256 F.3d 1349 (Fed. Cir. 2001) (MPEP 2131) as standing for the proposition that a claim that covers several alternatives is deemed anticipated if any of those alternatives is within the scope of the claims known in the art. The Office Action also stated the proposition that a genus does not always anticipate a species. But when a species is clearly named in the prior art, the species claim is anticipated no matter how many other species are named, citing to *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990).

## **II. The Applicants' Remarks**

In the present application, the Applicants submit that Berrier et al., cited as anticipating claims 13-19, 21-28, 32, 33, 35, 36, 39-45, 47-63, and 65-67, does not disclose the particularly claimed arrangement of the elements as required by the independent claims. Berrier et al. discloses lists of numerous alternatives to various elements of a film (e.g., number of layers, material or combination of materials for each layer, % weight of material in each layer, layer thickness, etc.). Applicants determined that if by chance alone, one of ordinary skill in the art would have a 1 in 2500 probability (i.e., a 0.04% chance) of selecting the specific combination of elements and arranging them as required by the claims.

### **A. The Applicants' Response To The Cited Case Law In The Final Office Action**

#### **1. The Legal Precedent Cited In *Ex Parte A* Is More On Point Than The Facts Of *Ex Parte A***

The Applicants point out that the independent claims are directed to a specific combination of elements, namely, a single layer film, comprising nylon 66, in an amount of at least 90% by weight. *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) is cited for the proposition that when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named.

The facts in *Ex Parte A* are not on point to the present facts. In *Ex Parte A*, the claimed compound was identically described, that is, the exact claimed compound was included within a list containing 46 other compounds. The Board in *Ex Parte A* distinguished those facts from the legal precedent cited by the appellants

in *Ex Parte A*. The "numerous other precedents discussed by appellants, they invariably deal with a significantly different set of facts. In each case, to arrive at the claimed subject matter, it was necessary to select portions of that subject matter from various sections of the reference disclosure and combine them, e.g., selecting values for variable substituents to interpolate into a generic structural formula to arrive at a specific compound." *Ex Parte A*, 1990 Pat. App. LEXIS 19 (Pat. App. 1990). Among the precedents cited, was *In re Arkley*, 455 F.2d 586, 172 USPQ 524 (CCPA 1972), discussed in detail below. The Applicants submit that the facts of the present application are more similar to the precedent cited by the appellants in *Ex Parte A*, than the facts of *Ex Parte A*.

As argued in more detail below, unlike in *Ex Parte A*, the exact structure of a film containing all the elements of the present independent claims is not found in a single portion of Berrier et al. Specifically, Berrier et al. fails to disclose in any single example (1) a single layer film, (2) comprising nylon 66, and (3) in an amount of at least 90% by weight. Rather, to form the rejection, the Office Action must select portions from various sections of Berrier et al. and judiciously combine them to meet all the features of the claimed invention. This is exactly the kind of rejection the Board admonished in *In re Arkley* (discussed in detail below), the precedent relied upon in *Ex Parte A*.

## **2. MPEP § 2131.01 And Case Law Cited Therein**

The Office Action citation to case law setting forth precedent for anticipation appears to be a partial copy of MPEP § 2131. The remaining case law not copied from MPEP § 2131 provides more specific guidance that Applicants submit is more probative to the present facts. This section of the MPEP not cited provides case law clarifying that a prior art reference must disclose the elements of a claim in the arrangement required by the claim. This remaining portion of the MPEP is as follows:

"The identical invention must be shown in as complete detail as is contained in the .. claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is

permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

a). *Berrier et al. And A Lack of A Clear and Unequivocal Teaching to Combine Listed Elements*

As cited above, MPEP § 2131 provides that for a prior art reference to anticipate a claim, it must be determined that the identical invention is shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Although the Applicants recognize this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required, the elements of the claim **must be arranged in the prior art as required by the claim**. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990) (emphasis added). One must determine whether the specifically cited portion of the prior art taken with the remainder of the reference is such as to place the claimed invention in the possession of the public. *In re Wiggins*, 488 F.2d 538, 542 (C.C.P.A. 1973) (holding that a reference's listing of specific compounds within the scope of the appealed claims "constituted nothing more than speculation about their potential or theoretical existence," and, hence, was not a "description" of the compounds within the meaning of § 102(b)).

In the present rejection using Berrier et al., the identical invention is not shown in one example or discussed in one portion of Berrier et al. in complete detail as required by the claims. Applicants note "virtually all [inventions] are combinations of old elements." If mere identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). The Applicants submit that the exhaustive list of alternatives in Berrier et al. is nothing more than speculation as to their theoretical application and does not place the presently claimed invention within the possession of the public.

b). *The "At Once Envisage" Requirement For Anticipation Of Under MPEP § 2131.02*

MPEP § 2131.02 provides guidance when the claims at issue are directed to a specific chemical compound, the cited prior art discloses a general formula for that chemical compound, and the prior art lists alternative substituents of the general formula. If one of ordinary skill in the art is able to "at once envisage" the claimed invention within the generic chemical formula, the compound is anticipated. One of

ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged." The word "envisage" is defined by the Webster's online dictionary as to "form a mental image of something that is not present." Thus, in the example of a chemical compound, one of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged."

The "at once envisaged" test of MPEP § 2131.02 has been applied to other types of claims and adopted by various courts. For example, the Court of Customs and Patent Appeals in *In re Arkley*, 59 C.C.P.A. 804, 807 (C.C.P.A. 1972) held that for a rejection under 35 U.S.C. § 102 (more specifically, Section 102(e)) to be proper, the cited reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the invention "without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 59 C.C.P.A. 804, 807 (C.C.P.A. 1972). The *Arkley* court stated: "such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the Applicants must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection." *In re Arkley*, 59 C.C.P.A. 804, 807 (C.C.P.A. 1972).

The Applicants submit that the present rejection does not satisfy the "at once envisaged" test under MPEP § 2131.02. As discussed above, the Applicants determined that if by chance alone the Examiner has a 1 in 2500 probability of picking, choosing, and combining various disclosures in Berrier et al. not directly related to each other to form the presently claimed invention. A 1 in 2500 chance is clearly not equivalent to a claim being "at once envisaged."

c). Ranges: Disclosure With Sufficient Specificity

The MPEP § 2131.03 also provides that when the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be

made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." This section of the MPEP acknowledges that what constitutes "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims. (The Applicants' evidence of unexpected results in support of a lack of specificity is provided in the accompanying Declaration of Dr. Robert Vimini, and discussed in more detail below.)

The Applicants submit that merely because a prior art reference contains an exhaustively broad list of alternatives to elements of a claimed invention the reference is not necessarily *per se* an anticipatory prior art reference. When confronted with this type of prior art reference, the above-cited case law directs the Examiner to consider whether one of ordinary skill would have had any difficulty in understanding or following the prior art disclosure in making the claimed combination, whether one of ordinary skill informed by the prior art reference would not have had to choose judiciously from an exhaustive list of possible combinations of elements to obtain the claimed invention, and whether one of ordinary skill in the art could at once envisage the claimed invention from the list of alternatives taught in the prior art. *In re Parameswar Sivaramakrishnan*, 673 F.2d 1383, 1385 (C.C.P.A. 1982).

### **3. Present Facts Are Analogous to *In Re Arkley***

The Applicants contend that the instant case is analogous to the facts in *In re Arkley*, 59 C.C.P.A. 804 (C.C.P.A. 1972), in which the Court of Customs and Patent Appeals overturned the Board's Section 102 rejection. The claim rejected as anticipated in *Arkley* was directed to a cephaloridine compound. The prior art reference did not identically describe the cephaloridine compound. Rather, Example 4 of the prior art reference disclosed precursors of the cephaloridine compound. Example 10 of the prior art reference disclosed that the claimed cephaloridine compound will be formed if an acid disclosed in Example 10 is first selected and then reacted with a particular tertiary amine. The particular tertiary amine was disclosed

in yet another different portion of the prior art reference. Thus, although all the elements of the compound were disclosed in the prior art reference, their exact combination was never disclosed. The *Arkley* court held: "there is nothing in the teachings relied upon by the Patent Office which 'clearly and unequivocally' directs those skilled in the art to make this selection [the claimed invention] nor any indication that Flynn [the prior art named inventor] ever made the selection himself."

*In re Arkley*, 59 C.C.P.A. at 808.

The Applicants make the following comparison:

<b>Present Facts</b>	<b><i>In re Arkley</i></b>
Berrier et al. fails to identically describe the claimed monolayer film comprising at least 90% nylon 66.	The prior art reference did not identically describe the claimed cephaloridine compound.
At ¶ [0016], the rejection contends that Berrier et al. discloses that a film may be from 1-9 layers, e.g. it may be a monolayer. Berrier et al. expressly states that this embodiment is not shown.	At one location in the prior art reference, e.g., Example 4, precursors of the claimed cephaloridine compound were disclosed.
At ¶ [0042] the rejection contends that Berrier et al. discloses that the sealant layer (which is the same as the first layer, when the film is a monolayer film) (See ¶ [0016] and [0023]) may comprise a polyamide in an amount up to at least 90%.	At another location of the prior art reference, e.g., Example 10, it was disclosed that the claimed cephaloridine compound will be formed if an acid disclosed in Example 10 is first selected and then carefully reacted with a particular tertiary amine.
At ¶ [0036] (one of eleven paragraphs discussing alternative polyamide compositions) the rejection contends that nylon 66 is disclosed.	At yet another location in the prior art reference, the particular tertiary amine was disclosed.
Applicants submit that monolayer films comprising nylon 66 were not contemplated by Berrier et al. because Table 4 lists seal strength results for the Reynolds® bag (a 60% nylon 66, monolayer bag, ¶ [0133]) that are outside of the disclosed seal strength values for bags contemplated by Berrier et al. See ¶ [0073]. Thus, nothing clearly and unequivocally directs one skilled in the art to combine the claimed elements of monolayer, at least 90% and nylon 66	Court held that there was nothing in the prior art reference which 'clearly and unequivocally' directed those skilled in the art to make this selection of elements.
Out of the 28 example films, none were monolayer films of nylon 66. Only films identified as "Comparative films" at one portion of Berrier et al. were monolayer films containing nylon 66 (that of Reynolds® and Gem Polymer). Moreover, Berrier et al. expressly states that a monolayer film is not shown in the figures. The Applicants submit that this is evidence that Berrier et al. failed to make the selection of elements to form the claimed monolayer film of at least 90% nylon 66.	There was no indication that the prior art reference ever made the selection of elements to form the claimed compound.

As shown in the table above, the present facts are closely akin to the facts in *Arkley*.

**B. Berrier et al. Teaches Away From The Presently Claimed Combination Of Elements**

Perhaps even more compelling, the specification of Berrier et al. would dissuade one from making the claimed selection of elements to form a monolayer, nylon 66 film in an amount of at least 90% by weight. The claimed bag is similar in composition to the monolayer film made by Reynolds® or Gem Polymer as described in ¶ [0117] and ¶ [0133]. The Applicants submit that these films were not contemplated as part of the invention in Berrier et al. At paragraph [0117], two "Sample" films are described. These films are identified as monolayer films comprising a blend of nylon-6 and nylon 66 manufactured by Reynolds® and Gem Polymer. In Table 4, the seal strength of these films was tested and compared to Exemplary films 13, 19, and 21. The results in Table 4 show that only at seal temperatures above 338°F did the Reynolds® and Gem Polymer bags seal, and only with a seal strength of 0.439 and 0.00754 lb/in, respectively. At the same seal temperature, Examples 13, 19, and 21 of the invention of Berrier et al. had seal strengths of 9.41, 9.61, and 8.78 lb/in, respectively. Thus, the Example films had a much stronger seal strength at the same seal temperatures. Most importantly, the specification of Berrier et al. disclosed acceptable seal strengths for films of that invention. At ¶ [0072], Berrier et al. teaches that at seal temperatures of about 290-300°F, acceptable seal strength may be from 1-10. See ¶ [0073]. Clearly, the Reynolds® and Gem Polymer monolayer films do not fall within this range. Therefore, the Applicants submit that Berrier et al. did not contemplate at least the monolayer nylon-6, nylon 66 films of Reynolds® and Gem Polymer to be part of the acceptable films of that invention, which is further evidence that Berrier et al. fails to identically disclose the presently claimed invention.

The disclosure of the elements of the claimed invention are not found within the same paragraph, or contiguous paragraphs of Berrier et al. In addition, it is submitted that Berrier et al. did not contemplate the claimed film as part of that invention. Therefore, the Applicants contend that in forming the rejection, the Office Action is picking, choosing, and combining various disclosures not directly related to each other by the teachings of Berrier et al. One skilled in the art would not be able

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to at once envisage the invention from the disclosure of Berrier et al., particularly in view of the apparent disclosure in Berrier et al. that monolayer nylon 66, films did not meet the acceptable seal strength limitations. The Applicants submit that, like in the decision by the court in *Arkley*, the present Office Action anticipation rejection using Berrier et al. should be withdrawn.

**III. The Reynolds® Oven Bags And Dr. Vimini's Declaration of Unexpected Results**

As discussed during the Examiner interview of 20 June 2006, during the review of Berrier et al., Applicants pointed out that Berrier et al. describes an oven bag made from a comparative film commercially available from Reynolds Metal Products, Inc. sold under the Reynolds® trademark.

It is the Applicants' understanding that the Reynolds® Oven Bag is a monolayer film of nylon 66, where the nylon 66 makes up about 60% wt of the composition of the film. A difference between the Reynolds® Oven Bag and the claimed bag is that the Reynolds® Oven Bag is only 60% wt nylon 66 whereas the claims, as amended, require a film of at least 90% by weight nylon 66.

MPEP § 2144.05 provides that when claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). In the present case, the composition wt% of the Reynolds® Oven Bag does not overlap the claimed range of "at least 90% by weight." No *prima facie* case for obviousness can be made.

Alternatively, it may be argued that the Applicants are merely optimizing the concentration of nylon 66 because § 2144.05 of the MPEP provides that differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

To proactively rebut this argument, the Applicants submit a Declaration by Dr. Robert Vimini as evidence showing the criticality of the nylon 66 concentration of at least 90% weight. The attached Declaration sets forth an evaluation of the

Reynolds® Oven Bag and an exemplary bag according to the present invention, i.e., a bag made from a monolayer film comprising at least 90% nylon 66 (the "Claimed Bag").

The results of the evaluation of the test performed on the Reynolds® Oven Bag are evidence of the criticality of the amount of nylon 66 in the film. The Declaration shows that the Reynolds® Oven Bag adhered to the turkey breast meat during its removal, and surprisingly and unexpectedly, the Claimed Bag did not adhere to the cooked, turkey breast meat upon its removal. In addition, the Reynolds® Oven Bag ballooned during cooking to form a gap between the top surface of the turkey and the bag of about 6 inches. In contrast and unexpectedly, the Claimed Bag was not observed to balloon to such an extent. The Claimed Bag was observed to form a gap between the top surface of the turkey and the bag of only about 3 to 4 inches.

The percentage weight difference in the amount of nylon 66 in the composition of the Reynolds® Oven Bag and the Claimed Bag may be expected to produce some differences in the properties of the respective films. But, MPEP § 716.02 provides that the issue is whether the differences in the properties are to such an extent that the difference is really unexpected. *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986). In the present invention, the Applicants submit and the Declaration by Dr. Vimini provides evidence that the different results observed for the Reynolds® Oven Bag compared to the Claimed Bag are indeed, quite surprisingly unexpected.

#### **IV. Conclusion**

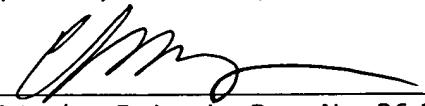
The Applicants provide valid, legal precedent, with facts similar to the present rejection, where it was held that even though all the elements of a claim were disclosed in a single prior art reference, there is nothing in the teachings relied upon by the Patent Office which 'clearly and unequivocally' directs those skilled in the art to make this selection the claimed invention or where one skilled in the art could at once envisage the claimed invention. Withdrawal of the rejection on this basis is respectfully requested.

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In addition, the Applicants proactively provide evidence of surprising and unexpected results from the difference of the claimed invention from that of the Reynolds® Oven Bag.

The Applicants submit the pending claims are distinguishable over the cited art and respectfully requests the claims be passed to allowance.

Respectfully submitted,

  
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Enclosure: Declaration of Dr. Robert Vimini

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